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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,066

07/25/2003

Pranela Rameshwar

4164

26259

7590

09/25/2006

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/628,066

Applicant(s)

RAMESHWAR ET AL.

Examiner

MISOOK YU, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,12-14,18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2 and 6 is/are allowed.
- 6) ☒ Claim(s) 12-14,18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/8/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Sequence alignment</u> .               |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse SEQ ID NO: 14 filed on July 12, 2006 is acknowledged. Since applicant's argument is persuasive, the species election requirement is withdrawn and search is expanded to other species in the claims.

Claims 1, 2, 6, 12-14, 18 and 20 are pending and examined.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As currently construed claim 12 depends on claim 1, whose scope is limited to two species (i.e. SEQ ID NO: 1 and 2). However, the limitation "the molecule specifically hybridizes to a coding sequence comprising SEQ ID NO: 15" makes the property boundary of claim 12 vague and confusing. The hybridizing molecules would be genus that the two species in the base claim belong to. If the purpose of claim 12 is to characterize the two species of the base claim to hybridize to SEQ ID NO: 15, then claim 12 does not further limit the base claim because the scope would be identical. If the claimed invention is all hybridizing molecule to SEQ ID NO: 15, then scope of the claim 12 is outside of the base claim.

For the purpose of this Office action, the Office interprets the scope of claim 12 is not limited to the two species of the base claim. However, this treatment does not relieve applicant the burden of responding to this rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-14, 18, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 12-14, 18, and 20 are interpreted as drawn to a genus of DNA molecules with various degrees of variations from SEQ ID NO: 1, 14, or 15.

The applicable standard for the written description requirement can be found: MPEP 2163; University of California v. Eli Lilly, 43 USPQ2d 1398 at 1407; PTO Written Description Guidelines; Enzo Biochem Inc. v. Gen-Prove Inc., 63 USPQ2d 1609; Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111; and University of Rochester v. G.D. Searle & Co., 69 USPQ2d 1886 (CA FC 2004).

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics,

structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is partial structure of "specially hybridizes" in claim 12, and "at least about 500 nucleotides" of SEQ ID NO: 1 in claim 13. There is not even identification of any particular portion of the structure that must be conserved in order to have the recited function in claim 13. As for claim 12, the genus of partial structures is not distinguishing identifying characteristics, i.e. no function/structure correlation. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

In addition, the specification has following definition:

"A "coding sequence" or "coding region" refers to a nucleic acid molecule having sequence information necessary to produce a gene product, when the sequence is expressed.

Claim 2 suggests that at least one species of a coding sequence is protein sequence. However, the specification does not teach which protein is being encoded by SEQ ID NO: 15. There are six possible protein encoding sequences in SEQ ID NO: 15.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116). As discussed

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above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of nucleic acid molecules, given that the specification has only described SEQ ID NO: 1 and 14. Therefore, only isolated nucleic acid comprising SEQ ID NO:1 and 14, but not the full breadth of the claim meets the written description provision of 35 U.S.C. §112, first paragraph.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-14, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 87/07643 (A1 of IDS).

Claims 12-14, 18, and 20 are interpreted as drawn to DNA molecules similar to SEQ ID NO: 1, 14 or 15.

WO 87/07643 teaches a DNA molecule that hybridizes to SEQ ID NO: 15. Note the attached sequence alignment. Although claim 13 recite “a fragment of at least 500 nucleotides of SEQ ID NO:1”, it is not clear whether the claimed invention is limited to at least 500 contiguous nucleotides of SEQ ID NO: 1 or at least 500 nucleotides that has a part of SEQ ID NO: 1. Since claim 20 depends from claim 13, and broadly drawn to any hybridizing molecule to a coding sequence of SEQ ID NO: 15, it is the Office's position that nucleic acid disclosed in WO 87/07643 meet the limitation. Since the claimed structure and the DNA structure taught by WO 87/07643 are same, the DNA structure

inherently has the promoter activity, especially given that WO 87/07643 teach 5' untranslated region at Fig. 1.

***Allowable Subject Matter***

Claims 1, 2 and 6 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

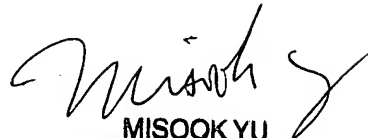
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MISOOK YU, Ph.D.

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Primary Examiner  
Art Unit 1642

  
MISOOK YU  
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